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| EXAMINER |
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DIXON, ANNETTE FREDRICKA

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3771

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06/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/725,048

Applicant(s)

BAZIN ET AL.

Examiner

Annette F. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-20, 24-48, 59, 61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-20, 24-48, 59, 61 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Appeal Brief filed on March 14, 2008. Examiner acknowledges claims 4-20, 24-48, 59, 61, and 63 are pending in this application, and with claims 5, 9, 10, 12-20, and 24 having been withdrawn from consideration.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4, 6, 7, 11, 25-48, 59, and 60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment may introduce new matter into the disclosure of an application after its filing date. MPEP § 608.04.

Specifically, independent claims 4, 11, 25, 37, 38, 46, 48, and 59 now recite(s) the claim limitation(s) “not a fingerprint or fingerprints” and “does not include a tooth or teeth”; however, the originally filed disclosure does not provide evidence that Applicant possessed the newly claimed invention at the time the application was filed. In fact, the original specification of the instant invention discloses “the external portion could include

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an area of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual” (Page 4, Lines 10-17). Applicant is reminded that “any negative limitation or exclusionary proviso must have basis in the original disclosure.” MPEP §2173.05(i). There is no specific recitation or support for Applicant’s invention to not be used for fingerprints or on the tooth in the original disclosure as filed; and therefore the subject matter added to independent claims 4, 11, 25, 37, 38, 46, 48, and 59 is considered new matter and must be cancelled from the claim(s). See *In re Johnson*, 558 F. 2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977); *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984); and *Ex parte Parks*, 30 USPQ2d 1234, 1236 (bd. Pat. App. & Inter. 1993).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 6, 7, 11, 25-48, 59, and 60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. No amendment may introduce new matter into the disclosure of an application after its filing date. MPEP § 608.04.

Specifically, Applicant appears to be claiming multiple embodiments with in one claim. For example: Claim 4 recites a transfer member wherein the transfer member is applied to an external body portion and then later recites a transfer member (assumed

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to be the same transfer member) is applied to an external body portion having a cosmetic product applied thereto. The indefinite nature of the claims lies in that:

1) Applicant discloses the application of a transfer member to an external body portion not having a cosmetic product for a diagnosis of skin conditions (Page 21, Line 15 thru Page 22, Line 2) and discloses the application of a transfer member in combination with a cosmetic product (Page 19, Lines 9-17); however, there is no recitation of both processes utilizes together as Applicant has claimed.

2) Examiner is uncertain if the transfer member of claim 4, line 4 is the same as the transfer member of claim 4, line 14. Within Applicant's disclosure, there is no recitation of a process wherein there are two transfer member utilized.

3) Examiner is uncertain if an additional step is missing or if the limitations of claim 4, lines 13-17 are out of order. Examiner is uncertain where in the process is the cosmetic agent applied to the external body portion. Why is the same or a different transfer member being placed on to the external body portion with or with out a cosmetic agent after the image of the transfer member has been scanned?

Without undue experimentation, Examiner cannot ascertain Applicant's claimed invention. Further, as similar indefinite claim language of claim 4 is perpetuated throughout the remaining independent claims 11, 25, 37, 38, 46, 48, and 59, Examiner requests Applicant carefully review the each of the claims to ensure that only one disclosed embodiment is recited.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6, and 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,343,536 to Groh.

As to Claims 4 and 6, Groh discloses a process for acquiring scanned image data relating to an external body portion (skin) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member, wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another, wherein the transfer image is not a fingerprint or fingerprints, and wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of the external body portion (cell and comedone presence, size, etc), and/or at least one product applied to the external body portion,

wherein the transfer member is placed in contact with an external body portion that is capable of including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product. Yet, Groh does not explicitly teach the application of the transfer member in contact with a cosmetic product applied to an external body portion. The system disclosed by Groh is used to detect comedones, which often appear on the face. (Figure 2, Column 3, Lines 64-67). Since application of cosmetic products is a common practice, any facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data. Further, as the process of cleansing the skin (for example: utilizing water rather than soap) may result in residual cosmetics being scanned. Therefore, it would have been obvious to one having ordinary skill in the art at time the invention was made to modify the device of Groh to capture facial cosmetics worn by the patient, as the Applicant has done.

Regarding claims 61-62, a "grade" (average number of comedones) that is indicative of at least one condition (accumulation of dirt in sebaceous glands) of the external portion is provided and stored in a database (col. 3, lines 1-32).

8. Claims 37, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Kvedar (Kvedar, J.C. et al. (1999). Teledermatology in a Capitalized

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Delivery System Using Distributed Information Architecture: Design and Development. *Telemedicine Journal*, 5(4), 357-366.).

As to Claim 37, the image can be compared to at least one other image formed from image data stored in and retrievable from an image database (col. 3, lines 1-32). Yet Groh does not explicitly teach the comparing of the displayed image. However, at the time the invention was made the use of comparing displayed images was known. Specifically, Kvedar teaches the comparison of images for the purpose of assessing the progress of the patient's treatment (Page 362, Column 2, Paragraph 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to compare images as taught by Kvedar to monitor the progression of the patient's treatment and determine appropriate care methods.

As to Claim 46, the image is displayed and viewed to analyze the characteristic of the external body portion. Regarding claim 59, the analysis is performed using an image analyzer. However, at the time the invention was made the use of comparing displayed images was known. Specifically, Kvedar teaches the comparison of images for the purpose of assessing the progress of the patient's treatment (Page 362, Column 2, Paragraph 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to compare images as taught by Kvedar to monitor the progression of the patient's treatment and determine appropriate care methods.

As to Claim 47, the system of Groh/Kvedar teaches the transfer member is placed in contact with the external body portion. As addressed in claim 4, the system

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disclosed by Groh is used to detect comedones, which often appear on the face. (Figure 2, Column 3, Lines 64-67). Any facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data. Further, as the process of cleansing the skin (for example: utilizing water rather than soap) may result in residual cosmetics being scanned. Therefore, it would have been obvious to one having ordinary skill in the art at time the invention was made to modify the device of Groh to capture facial cosmetics worn by the patient, as the Applicant has done.

9. Claims 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Kvedar (Kvedar, J.C. et al. (1999). Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development. *Telemedicine Journal*, 5(4), 357-366.) and Murad (6,296,880).

As to Claim 59, the system of Groh/Kvedar discloses all the recited elements with the exception of the analysis equipment. However, at the time the invention was made the use of the recited analysis equipment was known. Specifically Murad teaches the use of corneometer to detect the progress of treatment regimens for a patient suffering with acne. (Column 28, Lines 50). Therefore, it would have been obvious to one having ordinary skill in the art at time the invention was made to modify the system of Groh/Kvedar to include the use of a corneometer as taught by Murad, as a method of detecting the health of the skin in relationship to treatment methods.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Sheng (6,801,343).

As to Claim 48, information regarding the transfer image is collected to form a database (computer storage of binary filtered and normalized data, retrievable therefrom; col. 3, lines 1-32) for use in diagnosis or treatment recommendation determinations. Regarding the scanning of the image, Groh discloses, many image analysis hardware and software packages may be utilized to convert the transfer member image to a binary image (Column 4, Lines 60-62); yet Groh does not expressly disclose the use of a document scanner to scan the image from the transfer member. However, at the time the invention was made the use of a document scanner to convert the transfer member image to a binary image was known. Specifically, Sheng discloses the use of a flat bed image scanner to scan a document or picture (13) to a digitized format for conveying the image to a computer. (Column 1, Lines 8-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a flatbed image scanner as taught by Sheng, to enable the transfer of an image to a computer.

11. Claims 25-36 and 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Kvedar (Kvedar, J.C. et al. (1999). Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development. *Telemedicine Journal*, 5(4), 357-366.) and Sheng (6,801,343).

As to Claims 25-36, and 38-45, Groh discloses the previously described process for acquiring scanned image data relating to an external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of

the external body portion (cell and comedone presence, size, etc), and/or

at least one product applied to the external body portion.

The image scanner is associated with a first computer (col. 2, last line). Groh does not specify transmitting the image to another computer/location for analysis.

Kvedar et al. disclose a process for acquiring scanned image data relating to an external body portion. Kvedar et al. disclose that an image of an external body portion is captured and image data for the image representative of the external body portion is uploaded onto a first computer. The process may further include transferring the scanned image data, via the Internet, to a second computer located at a location remote from the first location (p. 361, for example), so that other users (specialists) can view

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the images for consultation, to allow remote and repeatable analysis of a condition of the external portion. Kvedar et al. also disclose storing the scanned image data on a data storage medium (computer file), and wherein the transferring may include shipping (via email attachment) the data storage medium to the second location. Once the image data is transferred to the second location, the image is displayed at the second location and viewed to analyze the image characteristics. Kvedar et al. disclose that the scanned image data can be sent to a plurality of locations to be analyzed numerous times. Kvedar et al. disclose that after the data is sent to a second location and analyzed, a recommendation for treatment can be provided (p. 362, col. 2; “(2)”), wherein the external portion is monitored during treatment (“Routine follow-up calls”) and information is provided regarding the effectiveness of the treatment (“assess their progress”). The recommendation is capable of being any recommendation determined by the specialist, including the use of a cosmetic or dermatologic product on the external portion (Kvedar et al. disclose this procedure to be used in treatment of *dermatologic* disorders, which are treatable with *dermatologic* products). The treatment recommendation is provided to the individual and/or treatment provider (p. 362; col. 2) via the Internet. Kvedar et al. disclose transferring questionnaire data (“history forms”) to the second location, wherein some of the data concerns the condition of the external product and any products applied thereto. The examiner takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to send “at least one of billing information and payment information” to the second location, as is common business practice, in order for the consulting specialist to receive payment for their services. This is well within the

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performance of a normal business interaction, well known to one of ordinary skill in the art. The examiner also takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to provide product-ordering information along with the treatment recommendation given by the specialist, as is common practice, in order for the patient to obtain the product to be used for treatment. This is well within the performance of a normal patient-client interaction, well known to one of ordinary skill in the art.

Regarding the scanning of the image, Groh discloses, many image analysis hardware and software packages may be utilized to convert the transfer member image to a binary image (Column 4, Lines 60-62); yet Groh does not expressly disclose the use of a document scanner to scan the image from the transfer member. However, at the time the invention was made the use of a document scanner to convert the transfer member image to a binary image was known. Specifically, Sheng discloses the use of a flat bed image scanner to scan a document or picture (13) to a digitized format for conveying the image to a computer. (Column 1, Lines 8-35).

It would have been obvious to one skilled in the art at the time the invention was made to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion and the flat bed document scanner as taught by Sheng to enable the transfer of the image to a digitized computer format

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12. Claims 4, 7, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,533,971 to Stess et al.

As to Claims 4, 7, 8, and 11, Stess et al. disclose a process for acquiring scanned image data relating to an external body portion (torso) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (25/27; col. 5, lines 36-41) in contact with an external portion (torso; in contact via 23) of an individual so as to obtain a transfer image (mold) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image (Column 2, Line 57) with an optical image scanner (51) to obtain scanned image data for an image representative of at least one characteristic of

the external body portion (shape, surface contours, etc), and/or

at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual (via release layer 23) to produce, on the moldable material(27, Column 5, Lines 4-1, the surface profile of the skin. Although the transfer member (25/27) is not placed into direct

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contact with the skin, this is not required by the claim. Furthermore, the release layer can be extremely thin (0.005 inches in thickness), which allows the transfer member to be in sufficient enough contact with the skin to produce the surface profile of the skin on the moldable material. The transfer member is a fabric formed as an article of clothing (shirt).

Yet, Stress does not explicitly teach the application of the transfer member in contact with a cosmetic product applied to an external body portion. The system disclosed by Groh is used to detect comedones, which often appear on the face. (Figure 2, Column 3, Lines 64-67). Any facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data. Further, as the process of cleansing the skin (for example: utilizing water rather than soap) may result in residual cosmetics being scanned. Therefore, it would have been obvious to one having ordinary skill in the art at time the invention was made to modify the device of Groh to capture facial cosmetics worn by the patient, as the Applicant has done.

Response to Arguments

13. Applicant's arguments with respect to claims 4, 6-7, 11, 25-48, 59, and 60-62 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette F. Dixon whose telephone number is (571) 272-3392. The examiner can normally be reached on Monday thru Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771

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